

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-14 are pending in the application, with claim 1 being the independent claim. Claims 15-19 are sought to be canceled without prejudice to or disclaimer of the subject matter therein. Claims 8 and 14 are sought to be amended. New claim 20 is sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicant respectfully requests that the Examiner reconsider the outstanding objections and rejections and that they be withdrawn.

Restriction Requirement

Applicants have canceled claims 15-19 without prejudice to or disclaimer of the subject matter therein.

Claim Objections

The Office Action, at pages two and three, objected to claim 8 because:

[t]he wording "of a data signal and a clock signal" should be replaced with "of a data signal or a clock signal" so as to correctly indicated the programmable IO receives or sends either but not both as is believed to be the intent of the claim since the claim reads "said programmable IO pad is programmable to receive or send at least one" not both.

Accordingly, Applicants have amended claim 8 to delete the phrase "at least" and to replace "and" with "or" so that claim 8 recites: "The transceiver of claim 1, wherein said programmable IO pad is programmable to receive or send one of a data signal or a clock signal." Therefore, Applicants respectfully request that the Examiner reconsider and remove his objection to claim 8.

Rejections Under 35 U.S.C. § 112

The Office Action, at page three, rejected claim 14 under the second paragraph of 35 U.S.C. § 112 because "[c]laim 14 recites the limitations 'said multiple parallel ports' and 'said multiple serial ports' in lines 3-4 of the claim. There is insufficient antecedent basis for this limitation in the claim." Accordingly, Applicants have amended claim 14 to replace "said multiple parallel ports" with "said parallel port" and to replace "said multiple serial ports" with "said serial port". Therefore, Applicants respectfully request that the Examiner reconsider and remove his rejection of claim 14 under the second paragraph of 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 103

The Office Action, at page 4, rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over the 3Com document entitled "Ethernet III ISA Network Interface Card User Guide" (hereinafter "3Com"). Applicants respectfully traverse these rejections.

A prima facie case of obviousness has not been established. Section 2142 of the Manual of Patent Examining Procedure (M.P.E.P.) recites, *inter alia* (emphasis added), "[t]he examiner bears the initial burden of ***factually supporting*** any *prima facie* conclusion of obviousness." Section 2143 of the M.P.E.P. recites, *inter alia*, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . Exemplary rationales that may support a conclusion of obviousness include: (A) Combining prior art elements according to known methods to yield predictable results[.]"

Independent claim 1 recites:

A transceiver, comprising:

a plurality of pads, wherein at least one of said plurality of pads is a programmable IO pad capable of supporting at least two data protocols and at least two electrical specifications, wherein at least one of said plurality of pads is a programmable MDIO pad capable of supporting at least two data protocols and at least two electrical specifications; and

a plurality of ports in communications with said plurality of pads, wherein one of said plurality of ports is a parallel port in communications with said programmable IO pad.

The Examiner, at page four of the Office Action, concedes that (emphasis added):

3Com does not specifically teach wherein at least one of said plurality of pads is a programmable IO ***pad*** capable of supporting at least two data ***protocols*** and at least two electrical ***specifications***, and wherein at least one of said plurality of pads is a programmable MDIO pad capable of supporting at least two data protocols and at least two electrical specifications.

In light of this concession, the Examiner effectively asserts that 3Com teaches:

A transceiver, comprising:

a plurality of pads; and

a plurality of ports in communications with said plurality of pads, wherein one of said plurality of ports is a parallel port in communications with a pad.

From this alleged teaching of 3Com, the Examiner, at pages four and five of the Office Action, contends that (emphasis added):

However those of ordinary skill within the art at the time the invention was made would recognize that each of the *ports* (AUI, RJ-45, and BNC, also pages 81-83) supports different *protocols* and *specifications* required to operate and connect with each port is well known. Furthermore those of ordinary skill within the art at the time the invention was made would recognize that programming the pads of the 3C509B NIC or any network interface supporting a number of different ports (known as a "combo" in that art) for supporting the communication between whichever port is activated and the device it is connected to is well known.

Therefore one of ordinary skill within the art at the time the invention was made could have been motivated to modify 3Com to have each of the plurality of *ports* support different *protocols* and *specifications* since each is a different electrical connection, with its own unique specific protocols and specifications required for operations. Furthermore one of ordinary skill within the art at the time the invention was made could have been motivated to further modify 3Com to have the at least one programmable IO pad and MDIO pad supporting at least two of *the different protocols and specifications of the different ports* to allow connection with the device in which it is inserted by way of the standard contact points regardless of which port is activated/utilized.

Contrary to the features of claim 1 of: (1) a programmable IO *pad* capable of supporting at least two data protocols and at least two electrical specifications and (2) a programmable MDIO *pad* capable of supporting at least two data protocols and at least two electrical specifications, the Examiner contends that the teachings of 3Com can be modified to produce a transceiver that supports different protocols and specifications of different *ports*. Furthermore, even if, for sake of argument, the Examiner had contended that one of skill in the art would have: (1) knowledge of the features of claim 1 that he concedes are not taught by 3Com and (2) motivation to modify the teachings of 3Com to incorporate these features, such a contention would be a mere assertion without the *factual support* required by section 2143 of the M.P.E.P. to establish a prima facie case of obviousness.

For at least these reasons, the Examiner has failed to establish a prima facie of obviousness. Accordingly, claim 1 is patentable over 3Com. Because each of claims 2-14 depends upon claim 1 and because of the additional distinctive features of each of claims 2-14, each of these claims is also patentable over 3Com. Therefore, Applicants respectfully request that the Examiner reconsider and remove his rejections of claims 1-14 under 35 U.S.C. § 103.

New Claim

Applicants have added new claim 20. Support for new claim 20 can be found throughout the specification including, for example, at paragraphs 0027, 0028, 0031, 0036, and 0037. Because new claim 20 depends upon claim 1 and because of the additional distinctive features of new claim 20, this claim is patentable over 3Com. Applicants respectfully request that the Examiner pass new claim 20 to allowance.

Information Disclosure Statement

Applicants thank the Examiner for his acknowledgement of the Information Disclosure Statement (IDS) that was filed on October 31, 2007. However, an IDS was also filed on December 1, 2003, and included a Form PTO/SB/08b that cited eight documents for consideration by the Examiner. Applicants have not received a returned copy of this form with indications that the Examiner has considered these documents. Applicants respectfully request that this be done.

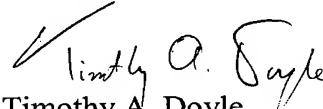
Conclusion

The stated grounds of objection and rejection have been properly traversed or accommodated. Applicants therefore respectfully request that the Examiner reconsider the presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Timothy A. Doyle
Attorney for Applicants
Registration No. 51,262

Date: 28 MAY 08

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

808406_1.DOC